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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,915	10/16/2001	Luc Desnoyers	GNE.2630P1C12	8309
7590 Ginger R Dreger Heller Ehrman White & McAuliffe LLP 275 Middlefield Road Menlo Park, CA 94025			EXAMINER BLANCHARD, DAVID J	
			ART UNIT 1643	PAPER NUMBER
			MAIL DATE 01/30/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/981,915

Applicant(s)

DESNOYERS ET AL.

Examiner

David J. Blanchard

Art Unit

1643

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 December 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 63-65, 68, 74 and 75.
Claim(s) objected to: _____.
Claim(s) rejected: 61, 62, 69 and 70.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s): _____.
13. ☐ Other: _____.

Continuation of 11. does NOT place the application in condition for allowance because: The rejection of claims 61-62 and 69-70 under 35 U.S.C. 102(a) as being anticipated by Fukushima et al [a] (WO 99/58668, published 11/18/1999) as evidenced by English equivalent Fukushima et al [b] (U.S. Patent 6,664,383 B1, cited on PTO-892 mailed 6/20/05) is maintained.

The response filed 29 December 2006 reiterates that based upon the holdings in *In re Stempel* and *In re Moore*, Applicants need to disclose only what is disclosed in the cited reference Fukushima et al in order to support the priority claim. Applicant acknowledges that the prior art of Fukushima et al disclose a sequence, SEQ ID NO:3, however, applicant argues that no specific examples or experimental data are provided regarding the use of SEQ ID NO:3 and the examiner has not disputed that Fukushima et al do not disclose any utility for their disclosed sequence. Applicant again points to US Provisional Application Serial No. 60/079,294 to which applicant claims benefit as disclosing the nucleic and amino acid sequence of the PRO337 polypeptide and argues that the disclosures of the cited prior art and US Provisional Application Serial No. 60/079,294 are identical. Applicants' arguments have been fully considered but are not found persuasive. Although the examiner has not disputed that Fukushima et al do not disclose any utility for their disclosed sequence, the examiner has not agreed that Fukushima et al do not disclose any utility for their disclosed sequence. In fact, the teachings of Fukushima et al disclose sequences that have been obtained by a cloning method that isolates genes encoding proliferation and/or differentiation factors functioning in hematopoietic systems and immune systems. More specifically, Fukushima et al disclose that the polypeptides of the invention promote differentiation and proliferation of chondrocytes and induce cartilage and/or bone growth, an activity of chondrocytes which are defined in the art as a cell embedded in cartilage that produces cartilage (col 12, lines 9-14, col 9, lines 12-16, in particular). Thus, while Fukushima et al do not provide specific examples or experimental data regarding the use of SEQ ID NO:3, Fukushima et al do disclose the activity possessed by the polypeptide, which is more than what applicant has shown in US Provisional Application Serial No. 60/079,294, which is limited to the disclosure of the sequences of instantly claimed PRO337. Applicant is reminded that under 37 CFR 1.131 practice, proof of a utility must be shown only if the reference discloses a utility. In *re Wilkinson*, 304 F.2d 673, 134 USPQ 171 (CCPA 1962); In *re Moore*, 444 F.2d 572, 170 USPQ 260 (CCPA 1971). Further, unlike the facts in *In re Stempel*, the instant claims recite a specific activity of the claimed molecule that was only established after the filing of Applicants' earliest priority document, US Provisional Application Serial No. 60/079,294. Applicant is invited to submit an appropriate affidavit or declaration under 37 CFR 1.131 showing prior invention. See MPEP 706.02(b) and MPEP 715. Thus, given that the prior art discloses more than what applicant has disclosed in their earliest priority document, US Provisional Application Serial No. 60/079,294 and in view that the claims recite a specific activity of the claimed molecule, the facts in the instant case are distinguished from the facts in *In re Stempel* and *In re Moore*.

Applicant asserts that the examiner is confusing whether the priority date of the instant application is earlier than that of the reference, versus whether Applicants are able to predate the Fukushima et al reference and thus, remove it as prior art, by demonstrating that as much of the claimed invention as is taught in the Fukushima et al reference had been reduced to practice by Applicants prior to the date of the Fukushima et al reference. Applicant states that the latter is relevant in this case and asserts that they can predate the Fukushima et al reference, again arguing with the *Stempel* doctrine. Applicants' arguments have been fully considered but are not found persuasive. As discussed above Fukushima et al disclose more than what applicant has disclosed in their earliest priority document, US Provisional Application Serial No. 60/079,294. Further, in the instant case, Applicant is claiming the activity based on the chondrocyte re-differentiation assay, which was first disclosed in PCT/US00/04341 (WO 00/53756), filed 2/18/2000, i.e., after the filing of US Provisional Application Serial No. 60/079,294. Thus, applicant has not disclosed the subject matter of claims 61-62 and 69-70 in a manner provided by 35 U.S.C. 112, first paragraph, in the earlier filed application, i.e., Applicant's priority document US Provisional Application Serial No. 60/079,294 does not provide adequate written support for the subject matter of the rejected claims. Again, Applicant is reminded that under 35 U.S.C. 120, a claim in a U.S. application is entitled to the benefit of the filing date of an earlier filed U.S. application if the subject matter of the claim is disclosed in the manner provided by 35 U.S.C. 112, first paragraph, in the earlier filed application. See, e.g., *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 47 USPQ2d 1829 (Fed. Cir. 1998); In *re Scheiber*, 587 F.2d 59, 199 USPQ 782 (CCPA 1978). A claim in a subsequently filed application that relies on a combination of prior applications may not be entitled to the benefit of an earlier filing date under 35 U.S.C. 120 since 35 U.S.C. 120 requires that the earlier filed application contain a disclosure which complies with 35 U.S.C. 112, first paragraph for each claim in the subsequently filed application. *Studiengesellschaft Kohle m.b.H. v. Shell Oil Co.*, 112 F.3d 1561, 1564, 42 USPQ2d 1674, 1677 (Fed. Cir. 1997). Applicants' assertion that the examiner is confusing two different issues (bottom of pg. 5 of response) is curious given that facts in the instant case are distinguished from *In re Stempel* and *In re Moore* (discussed supra) and applicant cannot antedate a prior art reference with a disclosure (US Provisional Application Serial No. 60/079,294) that does not comply with 35 U.S.C. 112, first paragraph for each claim in the subsequently filed application (i.e., the present application). The disclosure of the prior-filed application must provide adequate support and enablement for the claimed subject matter of the later-filed application in compliance with the requirements of 35 U.S.C. 112, first paragraph. See MPEP 201.11. If the application properly claims benefit under 35 U.S.C. 119(e) to a provisional application, the effective filing date is the filing date of the provisional application for any claims which are fully supported under the first paragraph of 35 U.S.C. 112 by the provisional application. See MPEP 706.02(V).

For these reasons and those already of record, the rejection of claims 61-62 and 69-70 under 35 U.S.C. 102(a) as anticipated by Fukushima et al [a] as evidenced by Fukushima et al [b] is maintained.

Respectfully,
David J. Blanchard
571-272-0827

